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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,732	04/08/2004	Yasuyuki Kawashima	11333/38	1524

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Chicago, IL 60610

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT	PAPER NUMBER
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1657

MAIL DATE	DELIVERY MODE
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03/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,732	Applicant(s) KAWASHIMA, YASUYUKI	
	Examiner Kailash C. Srivastava	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008 and 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Copy-Int. Summary</u> . |

DETAILED ACTION

1. The response and amendment filed 08 September 2008 to the Office Action mailed 01 May 2008 is acknowledged and entered.
2. Additionally, Applicants' response and Remarks filed 02 March 2009 to the Interview Summary mailed 12 February 2009 are acknowledged.

Informal Matters

3. The instant Office Action addresses Applicants' Remarks and amendments filed 08 September 2008 in response to Office Action mailed 01 May 2008 and the response and Remarks filed 02 March 2009 to the Interview Summary mailed 12 February 2009.
4. As Applicants assert in the response and Remarks filed 02 March 2009 to the Interview Summary mailed 12 February 2009, the instant non-Final U.S. Application (i.e., 10/821,732) has been assigned to Examiner Kailash C. Srivastava in Art Unit 1657. To aid in correlating any papers for the instant application (i.e., 10/821,732), all further correspondence regarding the instant application (i.e., 10/821,732) should be directed to Examiner Kailash C. Srivastava in Art Unit 1657.
5. The Examiner would like to clarify the record that contrary to the assertion made in the Remarks filed 02 March 2009 to the Interview Summary mailed 12 February 2009, during the interview on 09 February 2009, the Examiner was not informed "that if the rejection under 35 U.S.C. § 112, first paragraph is maintained in a future Office Action, Applicant will likely seek relief through an appeal to the Board of Patent Appeals and Interferences." (Please see, Remarks filed 02 March 2009, Page 2, Lines 20-22 and the underlined text described in the Interview Summary mailed 12 February 2009 at Lines 2-14).

Examiner respectfully submits that the remainder of the statement described in said response cited *supra* (i.e., Remarks filed 02 March 2009, Page 2, Lines 3-20) reflects the actual "substance of Interview".

Amendments and Response based Withdrawals

6. In view of remarks and amendments filed 08 September 2008, the following rejections in the Office Action mailed 01 May 2008 are hereby withdrawn:

- Anticipation rejection to Claims 11 -15, 17, 19, and 25-26 under 35 U.S.C. § 102(b) as anticipated by Fukuda et al (US Patent 6,165,740); and
- Obviousness rejection to Claims 11 -21 and 25-26 under 35 U.S.C. §103(a) as unpatentable over combined teachings from Fukuda et al (US Patent # 6,165,740, issued 26 Dec 2000) in view of Kubitschek et al (J Bacteriol, Dec 1986) and in view of Chupp et al (US Pat # 5,631,165, issued 20 May 1997).

Claims Status

7. Claims 1-10, 22-24 and 27 remain cancelled.
8. Claims 11-14, 20-21 and 25-26 have been amended;
9. Claims 11-21 and 25-26 are pending and are examined on merits.

Claim Rejections - 35 U.S.C. § 112,

1st Paragraph

10. The following is a quotation of the *1st* paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 19-21 and 26 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 19-21 and 26, Applicant recites the phrase "output part." In the instant specification as currently presented, the description of an "output part" is not described, and what would encompass such a part has not been clarified. Furthermore, even in any of the drawings what an "output part" is has not been shown. Therefore, sufficient written description has not been given in the specification as currently presented to demonstrate to one of skill that at the time when the claimed invention was filed applicants were in possession of the claimed invention.

In response to rejection to Claims 19-21 and 26 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement in Office Action mailed 01 May 2008, pointing to a

number of places in the specification as currently presented and the amended specification filed 08 September 2008; the presented argument is, “phrase “output part” recited in Claims 19-21 and 26 is described in and fully supported by the specification as filed”. “Moreover, Applicant further submits that the recited “output part” is clearly shown in the drawing (e.g., generally as “S9” in FIGS. 6 and 18 and, in specific embodiments, as liquid crystal touch panel “11” in FIGS. 10 and 19)”. (See, Remarks filed 08 September 2008, Page 5, Line 29-31 and Page 6, Lines 2-5).

A further argument presented in the response filed 08 September 2008 (See Remarks, Page 6, Lines 6-8) and in Remarks filed 02 March 2009 (Page 2, Lines 12-16) is, “Notwithstanding the above, this ground of rejection has been rendered moot by the present amendments to the specification, which provide *ipsissima verba* of the phrase “output part” recited in Claims 19-21 and 26.”

Examiner respectfully submits, all the discussion presented at various locations of the currently presented description in the specification (e.g., Page 5, Lines 22-24) as well as in the amendment to the specification filed 08 September 2008 is to a “Screen display” or what can be outputted to said display. The description that is provided at various locations that are referred to in the response filed 08 September 2009 does not describe what the “output part” *per se* is. Similarly, Drawings at Figure 10 does not show any part labeled as “Screen display”. It merely shows a box within which are presented some arrows and some written words. Additionally, the “S9” in FIGS 6 and 18 is a block within a flow-sheet diagram. There is no indication of any parts labeled as, “output part” in said Figures 6, 9, 10 or 18.

Applicants’ arguments filed 08 September 2008 regarding the lack of written description rejection of Claims 19-21 and 26 under 35 U.S.C. § 112, 1st Paragraph in the Office Action mailed 01 May 2008 have been fully and carefully considered but are not persuasive for the reasons of record at page 2, Lines 14-23 and Page 3, Lines 3-7 of said Office Action mailed 01 May 2008 and additional reasons discussed *supra*. Thus, the rejection of Claims 19-21 and 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement in Office Action mailed 01 May 2008, is maintained and is adhered to.

2nd Paragraph

12. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

13. Claims 19-21 and 26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In claims 19-21 and 26, Applicant recites the phrase "output part." Applicant does not provide any definition in the instant specification as to what an "output part" would encompass, and does not show such a part in any drawings, other than in a flow chart, where it is a block without defining the part *per se*, and as such, no particular definition for such a part has been provided, and therefore, it is unclear what Applicant means by this phrase.

In response filed 08 September 2008 to the above recited rejection to Claims 19-21 and 26 in the Office Action mailed 01 May 2008 to the phrase "output part", the presented argument to the rejection is, "As noted above, the phrase "output part" recited in Claims 19-21 and 26 is described in and fully supported by the specification as filed and is clearly shown in the drawings. Moreover, this ground of rejection has been rendered moot by the present amendments to the specification, which provide *ipsissima verba* of the phrase "output part" recited in Claims 19-21 and 26." (See, Remarks filed 08 September 2008, Page 6, Lines 11-19).

Please note, all the discussion presented at various locations of the currently presented description in the specification (e.g., Page 5, Lines 22-24) as well as in the amendment to the specification filed 08 September 2008 is to a "Screen display", not to an "output part", or what can be outputted to said display. The description that is provided at various locations that are referred to in the response filed 08 September 2009 does not describe what the "output part" *per se* is, or what is encompassed by said "output part". Drawings at Figure 10 does not show any part labeled as either "Screen display", or to an "output part". It merely shows a box within which are presented some arrows and some written words. Additionally, the "S9" in FIGS 6 and 18 is a block within a flow-sheet diagram. There is no indication of any parts labeled as, "output part" in said Figures 6, 9, 10 or 18.

Applicants' arguments filed 08 September 2008 regarding the rejection of Claims 19-21 and 26 under 35 U.S.C. §112, 2nd Paragraph in the Office Action mailed 01 May 2008 have been fully and carefully considered but are not persuasive for the reasons of record at page 3, Lines 10-20 of said Office Action mailed 01 May 2008 and additional reasons discussed *supra*. Thus, the indefiniteness rejection of Claims 19-21 and 26 under 35 U.S.C. §112, 2nd paragraph in the Office Action mailed 01 May 2008, is maintained and is adhered to.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Claims 19-21 and 26 are not allowed for the aforementioned reasons. However, Claims 11-21 and 25-26 are free of prior art. Claims 19-21 and 26 should be rewritten to overcome the rejection(s) under 35 U.S.C. §112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Upon resolution of the above-stated issues under 35 U.S.C. §112, further searching and/or consideration may be required.

16. Examiner, in a telephone interview (See attached Copy of the Interview Summary mailed 12 February 2009) offered a proposed Examiner's Amendment to bring the pending Claims 11-21 and 25-26 in a better condition for allowance. Said offer, however, was declined.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kailash C Srivastava/
Examiner, Art Unit 1657

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07 March 2009
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